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PATENT APPLICATION

ATTORNEY DOCKET NO. 10017270-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Richard P. Tarquini et al.

Confirmation No.: 3625

Application No.: 10/001,728

Examiner: S. B. Lemma

Filing Date: 10/31/2001

Group Art Unit: 2132

Title: **NODE AND MOBILE DEVICE FOR A MOBILE TELECOMMUNICATIONS NETWORK PROVIDING
INTRUSION DETECTION**

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on April 7, 2006.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

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Respectfully submitted,

Richard P. Tarquini et al.

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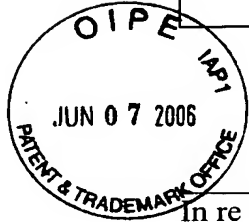
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Docket No.: 10017270-1
(PATENT)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Richard P. Tarquini et al.

Application No.: 10/001,728

Confirmation No.: 3625

Filed: October 31, 2001

Art Unit: 2132

For: NODE AND MOBILE DEVICE FOR A
MOBILE TELECOMMUNICATIONS
NETWORK PROVIDING INTRUSION
DETECTION

Examiner: S. B. Lemma

REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

As required under § 41.41(a)(1), this Reply Brief is filed within two months of the Examiner's Answer dated April 7, 2006, and is in furtherance of the Appeal Brief filed on January 23, 2006.

No fee is required for this REPLY BRIEF.

This brief contains items under the following headings pursuant to M.P.E.P. § 1208:

- I. Status of Claims
- II. Grounds of Rejection to be Reviewed on Appeal
- III. Argument
- IV. Conclusion

I. STATUS OF CLAIMS

The status of claims remains as identified in the Appeal Brief submitted January 23, 2006, wherein claims 1-13 are on appeal.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1 and 3-10 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,725,377 to Kouznetsov (hereinafter “*Kouznetsov*”);

Claim 2 is rejected under 35 U.S.C. § 103 as being unpatentable over *Kouznetsov* in view of U.S. Patent No. 6,851,061 to Holland (hereinafter “*Holland*”); and

Claims 11-13 are rejected under 35 U.S.C. § 103 as being unpatentable over *Holland* in view of U.S. Patent No. 5,557,742 to Smaha (hereinafter “*Smaha*”).

III. ARGUMENT

Appellant respectfully traverses the outstanding rejections of the pending claims, and requests that the Board reverse the outstanding rejections in light of the remarks contained herein. As in the Appeal Brief of January 23, 2006, Appellant argues many of the rejected claims separately. Thus, Appellant respectfully asserts that separately argued claims do not stand or fall together, *see* 37 C.F.R. § 41.37(c)(1)(vii).

Appellant hereby reasserts those arguments that are presented for the separately argued claims in Appellant’s Appeal Brief. For brevity, Appellant does not include those arguments herein, but instead submits the following supplemental remarks in reply to the Examiner’s Answer.

I. Rejections Under 35 U.S.C. § 102(e) over *Kouznetsov*

Claims 1 and 3-10

Claims 1 and 3-10 are rejected under 35 U.S.C. § 102(e) as anticipated by *Kouznetsov*. To anticipate a claim, a single reference must teach each and every element of the claim, *see* M.P.E.P. § 2131. Anticipation under § 102 requires “the presence in a single

prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984) (citing *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983)) (emphasis added). Therefore, anticipation under § 102 is not found in a situation where the claimed elements are arranged differently in the prior art. Moreover, § 102 anticipation is not found when the prior art is lacking or missing a specific feature or the structure of the claimed invention. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See M.P.E.P. § 2106, citing *Diamond v. Diehr*, 450 U.S. at 188-189.

A. Effect of Preamble

The primary issue in addressing the outstanding rejection of claim 1 is whether the preamble of the claim is to be given patentable weight, or can simply be ignored by the Examiner. The Examiner maintains that the preamble is to be given no weight, and thus asserts that the claim is properly rejected even though *Kouznetsov* provides no teaching of the subject matter recited in the preamble. Specifically, the Examiner asserts that the preamble sets forth an intended use clause, which is not afforded any patentable weight because the body of the claim does not refer back to, defined by, or otherwise draw life and breath from the preamble, *see* pages 11-12 of the Answer. Appellant strenuously disagrees and maintains that the preamble should be given patentable weight in the present case for the reasons discussed in the January 23, 2006 Appeal Brief and the further reasons provided below.

The preamble of claim 1 recites “A mobile device operable in a mobile telecommunications network, comprising:”. Contrary to the Examiner’s assertion, this does not recite an “intended use”, but instead clearly recites a structural element of the claim. The elements recited in the body of the claim are elements that the recited “mobile device” comprise. Thus, the body necessarily refers to and breathes life into the preamble, as the recited elements define elements of the mobile device. In this regard, the recitation of “mobile device” in the preamble clearly constitutes a structural limitation of the claim that should be afforded patentable weight.

Similarly, in *Kropa v. Robie*, 187 F.2d 150, 152, 88 U.S.P.Q. 478, 481 (CCPA 1951) (as discussed in M.P.E.P. §2111.02), a preamble reciting “An abrasive article” was deemed

essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated “it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an ‘abrasive article.’” Therefore, in *Kropa* the court determined that the preamble served to further define the structure of the article produced.

Like *Kropa*, the recitation of “mobile device” in claim 1 of the present application clearly defines the structure comprising the elements of the body of the claim. Also as in *Kropa*, every union of the elements recited in the body of the claim is not a “mobile device”, and thus the recitation of “mobile device” in the preamble of the claim defines the structure of the claim.

“[A] claim preamble has the import that the claim as a whole suggests for it.” *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 U.S.P.Q.2d 1816, 1820 (Fed. Cir. 1995). Further any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation, *see e.g., Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 U.S.P.Q.2d 1962, 1966 (Fed. Cir. 1989).

In view of the above and the further reasoning presented in the January 23, 2006 Appeal Brief, the preamble should be afforded patentable weight.

B. Kouznetsov Does Not Teach All Claim Elements

Kouznetsov does not anticipate independent claim 1 because *Kouznetsov* does not teach all elements of the claim. As discussed above, claim 1 recites “A mobile device operable in a mobile telecommunications network”. *Kouznetsov* provides no teaching of such a mobile device operable in a mobile telecommunications network.

In treating claim 1, the Examiner has completely ignored this element of the claim, asserting that it is to be given no patentable weight. Thus, the Examiner does not attempt to identify any teaching in *Kouznetsov* of such a mobile device operable in a mobile telecommunications network. However, in treating claims 7-9, the Examiner’s Answer (at

page 12 thereof) asserts that *Kouznetsov* teaches at column 1, lines 55-59 thereof: “By server, what is meant is any type of computer on which the software program is loaded.” However, *Kouznetsov* provides no express or inherent teaching of a mobile device. While *Kouznetsov* mentions that its server may be “any type” of computer, *Kouznetsov* simply fails to address mobility of any device and fails to provide any express or inherent teaching of a mobile device.

To anticipate a claim, “The identical invention must be shown in as complete detail as is contained in the ... claim.” M.P.E.P. §2131 *quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). The Answer concludes that “any type of computer on which the software program is loaded [in *Kouznetsov*] meets the limitation of portable device.” Page 12 of the Answer. Appellant respectfully disagrees. *Kouznetsov* provides no express or inherent teaching of a mobile device operable in a mobile telecommunications network. While *Kouznetsov* includes a broad statement that “server” means any type of computer, this is insufficient to expressly or inherently teach a mobile device operable in a mobile telecommunications network.

Kouznetsov fails to provide any detail regarding a mobile device operable in a mobile telecommunications network. Indeed, all of *Kouznetsov*’s teaching is directed toward servers that are shown and described as stationary devices, and *Kouznetsov* makes no mention whatsoever of a mobile device operable in a mobile telecommunications network. Further, *Kouznetsov* provides no teaching of how its anti-intrusion techniques may be employed for a mobile device, and is thus not enabling for use in such a device.

In view of the above, *Kouznetsov* fails to teach all elements of claim 1, and therefore the rejection of claim 1 should be overturned. Claims 3-10 depend from claim 1, and are therefore likewise allowable.

II. Rejections Under 35 U.S.C. § 103 over *Kouznetsov* in view of *Holland*

Claim 2

Claim 2 is rejected under 35 U.S.C. § 103 as being unpatentable over *Kouznetsov* in view of *Holland*. Claim 2 depends from independent claim 1. As discussed above, claim 1 is

in condition for allowance, and therefore for at least this reason claim 2 is likewise in condition for allowance.

Further, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. §2143. Without conceding any other criteria, Appellant asserts that the applied combination of *Kouznetsov* and *Holland* fails to teach or suggest all elements of claim 2, as discussed below.

As discussed above, claim 1 recites “an intrusion detection application stored in the memory module” of a “mobile device operable in a mobile telecommunications network.” As discussed above, *Kouznetsov* fails to teach or suggest this element. Further, the Examiner does not rely on *Holland* as teaching or suggesting this element, nor does it do so. Therefore, the combination of *Kouznetsov* and *Holland* fails to teach all elements of claim 1, from which claim 2 depends. Accordingly, for at least this further reason, the rejection of claim 2 should be overturned.

III. Rejections Under 35 U.S.C. § 103 over *Holland* in view of *Smaha*

Claims 11-13

Claims 11-13 are rejected under 35 U.S.C. § 103 as being unpatentable over *Holland* in view of *Smaha*. Appellant maintains that the rejection is improper for the reasons presented in the January 23, 2006 Appeal Brief. For brevity, those arguments are not re-presented here. Thus, Appellant respectfully requests that the rejection of claims 11-13 also be overturned.

IV. CONCLUSION

Appellant respectfully requests that the Board overturn the rejections of pending claims 1-13 for the above reasons.


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Date of Deposit: June 7, 2006

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